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**Filed** : **July 14, 2003**

### **REMARKS**

Claims 8 and 14 are amended herein. Support for the amendments is found in the specification, for example, at the paragraph spanning pages 6 and 7, and Figures 1 and 2. No new matter is added by the amendments.

Claim 18 is added herein. Support for new Claim 18 is found in the specification, for example, at page 4, second full paragraph. No new matter is added by new Claim 18.

Upon entry of the amendments, Claims 8, 10-12, 14, 15 and 18 are pending. Applicants respectfully request entry of the amendments and reconsideration of the application in view of the following remarks.

### **Rejection Under 35 U.S.C. §102(b)**

Claims 8, 10-12, 14 and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Masuda (U.S. Publication No. 2002/0064650). The Office Action states that Masuda discloses all elements of the claims.

Applicants respectfully traverse.

Claim 8, as amended, is directed to a transparent surface protective film for transparent conductive substrates protecting a surface opposite to a side of a conductive thin film of the transparent conductive substrates or a surface on a side of the conductive thin film, comprising: a transparent base material film, a transparent adhesive layer formed on and in contact with one side of the base material film, and a transparent antistatic layer formed on and in contact with the other side of the base material film, said transparent surface protective film being configured to maintain transparency even after one-hour heat treatment at 150°C, wherein the antistatic layer comprises polymers having pyrrolidinium rings as multiple repeating units in main chains thereof. Claims 10-12 and 15 depend from Claim 8.

Claim 14 is directed to a transparent surface protective film for transparent conductive substrates protecting a surface opposite to a side of a conductive thin film of the transparent conductive substrates or a surface on a side of the conductive thin film, comprising: a transparent base material film, a transparent adhesive layer formed on and in contact with one side of the base material film, and a transparent antistatic layer formed on and in contact with the other side of the base material film, said transparent surface protective film being configured to maintain

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transparency even after one-hour heat treatment at 150°C, wherein the antistatic layer comprises polymers having pyrrolidinium rings as multiple repeating units in main chains thereof, and wherein the entirety of the surface protective film is transparent.

### **Masuda**

Masuda is directed to a biaxially oriented polyester film for window application. Masuda teaches that the biaxially oriented polyester film contains a hard coat. Masuda further teaches that on the side opposite from the hard coat of the polyester film, a known sticking agent or adhesive is applied for pasting the film on window glass. Masuda teaches that the sticking agent or adhesive is applied on the antistatic coating of the biaxially oriented polyester film finished with orientation crystallization. Therefore, Masuda's adhesive is attached on one side to the antistatic coating, and on the other side, is not attached to another layer so as to be accessible for pasting the film on window glass.

### **Masuda does not Disclose All Claim Elements**

Claims 8 and 14 are not anticipated by Masuda because Masuda does not disclose a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film. Claims 8 and 14 recite that the film comprises a transparent adhesive layer formed on and in contact with one side of the base material film. Masuda, in contrast, discloses adhesive attached on one side to an antistatic coating, and on the other side, the adhesive is not attached to any layer, so as to be accessible for pasting the film on window glass. *Masuda* at paragraph [0044]. Thus, Masuda does not disclose a film comprising a transparent adhesive layer formed on and in contact with one side of the base material film. As such, Masuda does not disclose a film possessing all elements of Claims 8 and 14. Therefore, Claims 8 and 14 are novel over Masuda.

Applicants have found that a film with the recited configuration maintains transparency even after one-hour heat treatment at 150°C. Masuda does not contemplate such an arrangement or the beneficial properties Applicants have discovered. Accordingly, Claims 8 and 14, and claims dependent therefrom, are patentable over Masuda.

### **Claim 15**

Even if Masuda anticipated Claim 8, which Applicants do not concede, Masuda does not anticipate Claim 15. Claim 15 is directed to the transparent surface protective film of Claim 8,

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consisting of: the transparent base material film, the transparent adhesive layer formed on one side of the base material film, and the transparent antistatic layer formed on the other side of the base material film. Masuda, in contrast, discloses a film comprising a hard coat, antistatic coating, polyester film, and an adhesive. *Masuda* at paragraphs [0040]-[0044]. Masuda provides no teachings in which an adhesive is present but the hard coat is absent. Thus, Masuda does not disclose a film that has a transparent adhesive layer, base material film, and the transparent antistatic layer, but not a hard coat layer. Accordingly, Masuda does not disclose the transparent surface protective film of Claim 15. Accordingly, Claim 15 is novel over Masuda.

### **New Claim 18**

New Claim 18 is further patentable over Masuda. New Claim 18 is directed to the transparent surface protective film of Claim 8, where the adhesive layer is attached on a surface of a hard coat layer, anti-glare layer, or conductive thin film. Masuda clearly teaches that the hard coat layer is on the opposite side of the film relative to the adhesive. *Masuda* at paragraph [0044]. Thus, Masuda teaches an altogether different configuration than that recited in Claim 18. Further, Masuda teaches adhesive attached on one side to an antistatic coating, and on the other side, the adhesive is not attached to any layer so as to be accessible for pasting the film on window glass. Masuda does not teach an adhesive layer attached on a surface of a hard coat layer, anti-glare layer, or conductive thin film. If anything, Masuda teaches away from such a configuration. As such, Claim 18 is further patentable over Masuda.

### **Rejection Under 35 U.S.C. §103**

Claims 10 and 11 are rejected under 35 U.S.C. §103 as being obvious over Masuda (U.S. Publication No. 2002/0064650). The Office Action states that it would have been obvious to modify the Masuda reference to arrive at the recited adhesive layer thicknesses.

Applicants respectfully traverse.

Claims 10 and 11 cannot be obvious over Masuda because Claim 8, from which Claims 10 and 11 depend, is not obvious over Masuda. As discussed above, Masuda, teaches adhesive attached on one side to an antistatic coating, and on the other side, the adhesive is not attached, so as to be accessible for pasting the film on window glass. Applicants have found that a film with the configuration of Claim 8 maintains transparency even after one-hour heat treatment at

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150°C. Masuda does not contemplate such an arrangement or the beneficial properties Applicants have discovered. Accordingly, Claim 8, and Claims 10 and 11 dependent therefrom, are non-obvious over Masuda.

### **CONCLUSION**

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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